

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

VOITH PAPER GMBH & CO. KG	:	
	:	
Plaintiff,	:	Civil Action No. 07-226 (JJF)
	:	
v.	:	
	:	
JOHNSONFOILS, INC.	:	
Defendant.	:	

**DEFENDANT'S MOTION TO STAY THE PROCEEDINGS PENDING
REEXAMINATION OF THE PATENTS IN SUIT OR IN THE ALTERNATIVE FOR
LEAVE TO FILE A MOTION FOR SUMMARY JUDGMENT PRIOR TO AUGUST
20, 2008 THAT U.S. PATENTS 5,718,805 AND 5,972,168 ARE INVALID**

A. Defendant's Motion To Stay

Defendant, JohnsonFoils, Inc. ("JohnsonFoils"), hereby moves for an Order staying the proceedings and marking this matter as administratively closed for statistical and docketing purposes during the pendency at the United States Patent and Trademark Office of JohnsonFoils Request for Reexamination of U.S. patents 5,718,805 (the "805 Patent") and 5,972,168 (the "168 Patent") (collectively, the "Patents-in-Suit").

Support for this Motion is fully set forth in JohnsonFoils' accompanying Memorandum of Law and the referenced Exhibits 1-6 and Compendium of Unreported Cases. A proposed Order accompanies this Motion.

B. Defendant's Alternative Motion For Leave To File A Motion For Summary Judgment

In the event this Honorable Court declines to stay the proceedings, JohnsonFoils hereby moves this Honorable Court to grant leave to file a Motion for Summary Judgment that U.S. Patents 5,718,805 and 5,972,168 are invalid under 35 U.S.C. §103 at this time, rather than within 10 days of August 20, 2008. Support for this alternative Motion is fully set forth in JohnsonFoils' accompanying Memorandum of Law and the referenced Exhibits. A proposed Order accompanies this Motion.

Because the prior art clearly renders all claims of the Patents-in-Suit invalid, Defendant's motion for leave to file motion for summary judgment at this time, rather than within ten days of August 20, 2008, should be granted. A proposed Order accompanies this Motion.

Dated: August 28, 2007

Respectfully submitted,
Seitz, Van Ogtrop & Green, P.A.

/s/ Patricia P. McGonigle

George H. Seitz, III (DE #667)
gseitz@svglaw.com
Patricia P. McGonigle (DE #3126)
pmcgonigle@svglaw.com
222 Delaware Avenue, Suite 1500
P.O. Box 68
Wilmington, DE 19801
(302) 888-0600

- and -

Anthony S. Volpe (I.D. No. 24,733)
John J. O'Malley (I.D. No. 68,222)
Volpe and Koenig, P.C.
United Plaza, Suite 1600
30 South 17th Street
Philadelphia, PA 19103

CERTIFICATE OF SERVICE

I, Patricia P. McGonigle, Esquire, hereby certify that on this 28th day of August 2007, I electronically filed the foregoing pleading with the Clerk of Court using CM/ECF which will send notification of such filing to all counsel of record.

/s/ Patricia P. McGonigle

Patricia P. McGonigle (ID No. 3126)
pmcgonigle@svglaw.com

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VOITH PAPER GMBH & CO. KG

Plaintiff,

v.

JOHNSONFOILS, INC.

Defendant.

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Civil Action No. 07-226

CERTIFICATION PURSUANT TO LOCAL RULE 7.1.1

I, Ryan W. O'Donnell, as an attorney by *pro hac vice* admission for Defendant JohnsonFoils, Inc.'s (JohnsonFoils) hereby certify that that the following steps were taken to obtain the agreement of Plaintiff Voith Paper GmbH & Co. KG ("Voith") to consent to JohnsonFoils filing of its *Motion To Stay The Proceedings Pending Reexamination Of The Patents In Suit Or In The Alternative For Leave To File A Motion For Summary Judgment Prior To August 20, 2008 That U.S. Patents 5,718,805 And 5,972,168 Are Invalid.*

1. Since Voith filed its complaint on April 27, 2007 the parties were attempting to negotiate a resolution, and several stipulations for Extension of Time, D.Is. 6, 11, and 12, were approved by the Court and the time to respond was reset to August 16, 2007.

2. During settlement meetings in June 2007 between the parties, JohnsonFoils provided Voith with a document entitled "*Preliminary Partial Claim Construction For U.S. Patents 5,718,805 and 5,972,168*" which identified prior art disclosing the Verti-Forma twin wire former. JohnsonFoils advised Voith that if this

matter did not settle it would file requests for reexamination based on this prior art after it filed its Answer.

3. Prior to the Rule 16 Conference on August 1, 2007, JohnsonFoils counsel Anthony S. Volpe advised Voith's counsel, Michael J. Fink, that JohnsonFoils was still planning on filing the requests for reexamination if the matter did not set settle. Mr. Fink advised Mr. Volpe that Voith would oppose any stay.

4. On August 22, 2007, JohnsonFoils filed a *Motion For Summary Judgment That U.S. Patents 5,718,805 And 5,972,168 Are Invalid* based primarily on the Verti-Forma twin wire former prior art provided to Voith during the June 2007 settlement meetings. That motion was withdrawn on August 24, 2007 after Voith's counsel Michael J. Fink objected to the motion as premature under the Court's procedures.

5. On August 24, 2007, JohnsonFoils filed Requests for Reexamination of the Patents-in-Suit with the United States Patent and Trademark Office based primarily on the Verti-Forma twin wire former prior art provided to Voith during the June 2007 settlement meetings. The Requests for Reexamination were properly serve don Voith's patent prosecution counsel.

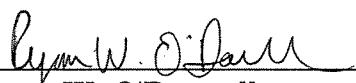
6. On August 28, 2007, I attempted to contact Voith's lead counsel, Michael Fink, to meet and confer regarding JohnsonFoils' Motion for Stay. Mr. Fink was not available and I left a voicemail requesting a return call to discuss the motion. I attempted to contact Voith's counsel again on that same day and spoke to

Neal Goldberg. Mr. Goldberg requested a copy of JohnsonFoils' Request for Reexamination and Motion For Leave of Court to Move for Summary Judgment prior to scheduling a meet and confer on this matter. I instructed Mr. Goldberg that the basis for JohnsonFoils' Motion for Leave of Court to Move for Summary Judgment was set forth in the summary judgment motion filed on August 22, 2007 (which was subsequently withdrawn).

7. For the reasons stated herein, despite the efforts made, JohnsonFoils has not been able to reach an agreement with opposing counsel on the matters set forth in the *Motion To Stay The Proceedings Pending Reexamination Of The Patents In Suit Or In The Alternative For Leave To File A Motion For Summary Judgment Prior To August 20, 2008 That U.S. Patents 5,718,805 And 5,972,168 Are Invalid*. Accordingly, JohnsonFoils respectfully requests the Court entertain the foregoing motion at the Court's convenience.

Respectfully submitted,

Dated: August 28, 2007



Ryan W. O'Donnell
[Admitted *Pro Hac Vice*]
Volpe and Koenig, P.C.
United Plaza, Suite 1600
30 South 17th Street
Philadelphia, PA 19103
(215) 568-6400
*Attorneys for Defendant
JohnsonFoils, Inc.*

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	:	Civil Action No. 07-226 (JJF)
Plaintiff,	:	
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v.	:	
	:	
JOHNSONFOILS, INC.	:	
Defendant.	:	

ORDER

AND NOW, this ____ day of _____, 2007, upon consideration of JohnsonFoils, Inc. ("JohnsonFoils") Motion To Stay The Proceedings Pending Reexamination Of The Patents In Suit Or In The Alternative For Leave To File A Motion For Summary Judgment Prior To August 20, 2008 That U.S. Patents 5,718,805 And 5,972,168 Are Invalid,

It is hereby ORDERED that JohnsonFoils Alternative Motion For Leave To File A Motion For Summary Judgment Prior To August 20, 2008 That U.S. Patents 5,718,805 And 5,972,168 Are Invalid is GRANTED.

It is further ORDERED that JohnsonFoils shall file its motion for Motion For Summary Judgment That U.S. Patents 5,718,805 And 5,972,168 Are Invalid within five (5) days of the entry of this Order.

BY THE COURT:

J.

IN THE UNITED STATES DISTRICT COURT
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Plaintiff,	:	
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ORDER

AND NOW, this ____ day of _____, 2007, upon consideration of JohnsonFoils, Inc. ("JohnsonFoils") Motion To Stay The Proceedings Pending Reexamination Of The Patents In Suit Or In The Alternative For Leave To File A Motion For Summary Judgment Prior To August 20, 2008 That U.S. Patents 5,718,805 And 5,972,168 Are Invalid,

It is hereby ORDERED that JohnsonFoils Motion to Stay is GRANTED.

It is further ORDERED that:

1. This stay shall be dissolved on motion by the parties after the final determination of all reexamination proceedings relating to any of the patents-in-suit in the PTO.

2. The Clerk of the Court shall mark this matter as administratively closed for statistical and docketing purposes, to be reopened pending the final outcome of any reexamination proceedings.

BY THE COURT:

J.